

**REMARKS**

This Amendment, submitted in response to the Office Action dated July 1, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-31 are all the claims pending in the application.

**I. Claim Objections**

Claims 1, 4, 9, and 12 have been objected to. Applicant submits that claims 1, 4, 9 and 12 are in proper form; however, in order to expedite the prosecution for this application, claims 1, 4, 9, and 12 have been amended to recite the word “having” as required by the Examiner. It is respectfully submitted that the claims are patentable without adding the word “having.” Consequently, Applicant respectfully requests that the objection to claims 1, 4, 9 and 12 be withdrawn.

**II. Rejection of claims 1-8, 17-26, 29 and 30 under 35 U.S.C. § 101**

Claims 1-8, 17-26, 29 and 30 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Examiner asserts that:

“[a] claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.” MPEP 2106 IV.B.2(b)

Further, the Examiner asserts that the claims do not indicate the use of hardware on which the software runs. Claim 1 has been amended as indicated above. Claims 17 and 20 are not claims directed to a process, but rather are claims directed to a system that recite structural

elements (e.g., “means for defining the object ...” and “means for receiving user-provided content ...”, etc.). The portion of the MPEP the Examiner cites is directed to process claims and thus not applicable to system claims 17 and 20.

Applicant believes that the amendments to the claims address the § 101 rejection, therefore, Applicant respectfully requests that the § 101 rejection of claims 1-8, 17-26, 29 and 30 be withdrawn.

**III. Rejection of claim 31 under 35 U.S.C. § 112, first paragraph**

Claim 31 has been rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. In particular, the Examiner asserts that the steps of “storing said custom content object in said one or more object servers; storing attribute information concerning the custom content object in said one or more object servers; and storing information specifying the custom content object and the attribute information in the library server” are not described in the specification.

“[S]toring said custom content object in said one or more object servers” is described at, for example, page 8, lines 14-19 and page 9, lines 7-11 of the specification. See also, Fig. 3, object server 48. “[S]toring attribute information concerning the custom content object in said one or more object servers” is described at, for example, page 10, lines 10-15. “[S]toring information specifying the custom content object and the attribute information in the library server” is described at, for example, page 8, lines 20-23, page 12, lines 1-5 and page 39, lines 1-5. See also, Fig. 3, library server 44.

Therefore, Applicant submits that the claim recitations are disclosed in the specification. Consequently, the 112, first paragraph rejection of claim 31 should be withdrawn.

**IV. Rejection of claims 1, 4, 6-7, 9, 12, 14-15, 17, 20, 22-23 and 25-30 under 35**

**U.S.C. § 103**

Claims 1, 4, 6-7, 9, 12, 14-15, 17, 20, 22-23 and 25-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over The McGraw-Hill Companies Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/> (hereinafter McGraw Web archive) and <http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt> (hereinafter McGraw PowerPoint Presentation).

Applicant respectfully submits the following in traversal of the rejection, assuming, only for the purposes of argument, that the McGraw PowerPoint Presentation qualifies as prior art.

**Claims 1, 9 and 17**

The Examiner asserts that McGraw PowerPoint Presentation, screenshot II where a user can choose a print book or an eBook and view and add material (see Office Action at pages 8 and 9), discloses “adding *user-provided content* to a content object stored as a plurality of content entities in a data repository,” as recited in claim 1. However, the material which a user can View and Add to a book shown in screenshot II, is part of pre-published content stored in the system of either McGraw reference. There is no teaching or suggestion that the content shown in screenshot II, which can be “added” or “viewed” such as “Reading 2: The Mischiefs of Faction, James Madison” or “Corley, et al.: The Legal and Regulatory Environment of Business, 11<sup>th</sup> Edition,” is provided by a user. In the portion of McGraw PowerPoint Presentation cited by the Examiner (screenshot II), the user merely selects the content that is to be added to a book being created. The reference does not disclose or suggest that the content itself is provided by a user.

Moreover, the content which the references discloses can be “added” or “viewed” is not “content *supplied* or *created* by the user,” as further recited in claim 1. Content such as “Reading 2: The Mischiefs of Faction, James Madison” or “Corley, et al.: The Legal and Regulatory Environment of Business, 11<sup>th</sup> Edition” are course material which are “designed exclusively for Primis” (see page 3 of McGraw Web archive) and stored in the Primis database. Although a user may select content from the content provided in the McGraw Primis database, at no point does the reference even suggest supplying user-provided content or content created by a user.

Consequently, the McGraw Web archive and the McGraw PowerPoint Presentation do not disclose “adding user-provided content to a content object” and “wherein the user-provided content is content supplied or created by the user” as recited in claim 1.

Claim 1 further recites “receiving user-provided content, *assigning* it an identifier, and storing it with its identifier in the data repository.” The Examiner asserts that:

“...the content of each section is the texts content. A section under a chapter, or the text of a section is an example of the content that will be provided by a user in order to compile a user own book by using the Add button. When a user activate[s] the Add button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the content of the chapter will be assigned an identifier that is the chapter name.” See Office Action at page 10.

On the contrary, the references indicate that when a user activates the Add button to add content of a section into his own book, the section that is selected by the user is added to the book. For example, if a user desires to add “New! Business Decision: Calling All Smokers” of Corley, et al.: The Legal and Regulatory Environment of Business, 11<sup>th</sup> Edition to the user’s own book, then “New! Business Decision: Calling All Smokers” will appear in the book being

created. It is respectfully submitted that there is no teaching or suggestion of *assigning* an identifier to the user provided content.

Accordingly, it is respectfully submitted that claims 1, 9 and 17 and their dependent claims are not rendered unpatentable by either of the McGraw references. Since claims 4, 12 and 20 recite similar elements, claims 4, 12 and 20 and their dependent claims should be deemed allowable for at least the same reasons.

**V. Rejection of claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 under 35 U.S.C.**

**§ 103**

Claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over McGraw in view of Rowe (U.S. Patent No. 6,073,148).

Claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 should be deemed patentable by virtue of their dependency to independent claims 1, 4, 9, 12, 17 and 20 for the reasons set forth above. Moreover, Rowe does not cure the deficiencies of the McGraw references nor is the combination of Rowe with the McGraw references obvious.

**VI. Rejection of claim 31 under 35 U.S.C. § 103(a) over McGraw in view**

**Santamaki**

Claim 31 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over McGraw in view of Santamaki et al. (USP 6,886,036). To the extent claim 31 recites subject matter similar to claim 1, claim 31 should be deemed allowable for at least the same reasons.

Claim 31 recites “storing said custom content object in said one or more object servers; and storing attribute information concerning the custom content object in said one or more object servers.” However, the Examiner has not established where the one or more object servers are

disclosed in the cited art. Moreover, the McGraw references do not teach that a custom content object and attribute information are stored in an object server.

Also, the Examiner concedes that the McGraw references do not disclose “storing information specifying the custom content object and the attribute information in the library server,” and cites Santamaki, col. 2, lines 25-28, to cure the deficiency. The respective column and lines cited by the Examiner discloses an e-book server 30, shown in Fig. 1, that stores an electronic document selected from a central server and which is converted into an e-book format. The e-book server of Santamaki stores an electronic document selected from a central server converted into an e-book format for later downloading to a remote e-book terminal. However, Santamaki provides no teaching or suggestion of storing information specifying a custom content object and attribute information concerning the custom content object in a library server (allegedly the e-book server 30, shown in Fig. 1 of Santamaki, as cited by the Examiner) in addition to storing the custom content object and attribute information in one or more object servers as required by claim 31. Rather, Santamaki merely discloses storing the document in an e-book format in the e-book server 30. Accordingly, even if the references were to be combined, the Examiner has not established a *prima facie* case of obviousness.

For at least the above reasons, claim 31 should be deemed allowable.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No. 09/488,976

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**VII. Conclusion**

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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**23373**

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